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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,794	01/09/2002	Jon Anthony Bell	RSW920010175US1	5106

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EXAMINER
ROMANO, JOHN J

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/042,794	BELL ET AL.
	Examiner	Art Unit	
	John J. Romano	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2005*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

- Remarks

1.   Applicant's amendment and response received March 17th, 2005, responding to

the December 17th, 2004, Office action provided in the rejections of claims 1-28.

Claims 1-31 remain pending in this application and which have been fully considered by

the examiner.

Examiner withdraws the 101 rejection of claims 10-17, corresponding to

applicants amendments to recite a "computer program product".

Applicant arguing for the claims being patentable over Mackin (see pages 10-14

of the amendment and response) primarily based on assertions on page 11, where

applicant contends that independent claims 1, 10, 18 and 19 are not anticipated by

Mackin, as *Mackin* does not disclose that the first executable product is instructed, <u>from</u>

<u>an external agent,</u> as amended, and arguments pertaining to the dependent claims are

not persuasive, as will be addressed under Prior Art's Arguments – Rejections section

at item 2 below. Accordingly, Applicants' amendment necessitated additional

clarifications, in light of the rejection of the claims over prior art provided in the previous

Office action, to further point out that Mackin also discloses as such claimed limitations

as now amended which will be provided and/or addressed under the item 2 below.

Thus, the rejection of the claims over prior art in the previous Office action is maintained

in light of the necessitated additional clarifications provided hereon and **THIS ACTION**

IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Prior Art's Arguments – Rejections

2.   Applicant's arguments filed March 17th, 2005, in particular on pages 10-14, have

been fully considered but they are not persuasive. For example,

(1) As to Claim 1, Applicant contends that *Mackin* does not disclose that the first

executable product is instructed, from an external agent, to provide a file containing

selected configuration data, as the instance application has recited and/or indicated in

Claim 1, which examiner strongly disagrees. However, while Applicants recognized that

Mackin uses OLE to implement some portion of the system and interacts with a user

interface, for example, a keyboard or mouse (See page 10, last paragraph, of the

amendment and response). Applicant, then concluded that *Mackin* teaches away from

waiting for an instruction from an external agent before creating the file containing the

configuration data as recited in amended Claim 1, by reciting "automatically" and which

examiner strongly disagrees.   Examiner agrees that *Mackin* teaches a method to

automatically transition configuration files; however, that process is inherently invoked

or started by an instruction form an external agent. *Mackin* explicitly discloses OLE as

acknowledged by the Applicant, and further discloses a user interface application used

for preparing an extraction plan (E.g., see Column 3, lines 37-41) and a transition from a

source computing system to a target computing system. Thus, the fact that *Mackin*

teaches an automated process, does not imply that it is not started by an instruction

from an external agent or an instruction from the user interface manually. *Mackin*

implicitly teaches externally launching an application via the OLE as when a OLE

embedded object is double clicked, for example, via a user interface, the application

associated with it is launched. Therefore, although *Mackin* does not explicitly disclose

launching an application to provide a file it is inherent in his teaching as the application

needs to be invoked to automatically migrate configuration files.

(2) Accordingly, Independent claims 10, 18 and 19 are not patentable over

Mackin for at least the reasons discussed above. As per claim 10, "...computer

readable program code configured to arrange...to write... ", is disclosed by Mackin (E.g.,

see Figure 4 & Column 7, lines 20-33), wherein computer readable program code is

arranged and transitioned (write) to the new computing system and "...computer

readable program code configured to obtain, responsive to the received command... ",

(E.g., see Figure 4 & Column 7, lines 54-60), wherein it is inherent that a function call is

responsive to a received command and is computer readable program code.

(3) As to claim 3, the examiner reasserts that a user interface is an external agent as well as a function call and practices and procedures in the field of COM and DCOM as taught by *Mackin* (Column 7, lines 45-65). Likewise, claim 18 "...<u>configured to output</u>..." is addressed by the response in claim 10 as the equivalent to write. Likewise, claim 19 is addressed by the limitations of claim 1, wherein "..<u>responsive to a command from an external agent</u>..." is the equivalent to instructing a first executable code to respond to a command from an external agent as claimed in claim 1.

(4) As to claims 12, 13 and 17, wherein Applicant asserts that there is no motivation or suggestion to combine the cited references as suggested in the Office action, the examiner strongly disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is old and well known in the art to run batch files in order to "...save time, resources, improve transition quality, and reduce user frustration" as disclosed by *Mackin* (E.g., see Column 3, lines 48-50). Furthermore, *Mackin* states throughout his application that his objective is to automate the transition process, which is implicit motivation to automate any and all parts of the process possible. In response to applicant's argument that the examiner's conclusion of obviousness is based upon

improper hindsight reasoning, it must be recognized that any judgment on obviousness

is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long

as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only

from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*,

443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Thus, the examiner reasserts the

rejections of claims 12, 13 and 17.

(5) As to dependent claims 4, 6, 21 and 22, wherein Applicant contends that the

examiner used hindsight reasoning, the examiner strongly disagrees. For example,

Mackin teaches the use of functions and OLE and user interface in which parameters

are inherently a part of as discussed above. In response to applicant's argument that

the examiner's conclusion of obviousness is based upon improper hindsight reasoning,

it must be recognized that any judgment on obviousness is in a sense necessarily a

reconstruction based upon hindsight reasoning. But so long as it takes into account

only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's

disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170

USPQ 209 (CCPA 1971).

(6) Applicant's arguments with respect to claims 29-31 have been considered

and rejected as discussed below in the rejection.

Claim Rejections

3.   Claims 1-31, are pending claims, stand finally rejected in light of the additional

clarifications provided and/or addressed at item 2 above, Prior Art's Arguments –

Rejections, as claims 1-3, 7-11, 14-16, and 18-20 are unpatentable over Mackin.

Claims 12, 13 and 17 are unpatentable over Mackin in view of Green and claims 4, 6,

21 and 22 are unpatentable over Mackin in view of Weschler. The claim rejections from

the previous office action of December 17th, 2004 are included corresponding to the

pending claims. Claims 29-31 are rejected according to rejection below.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under

section 122(b), by another filed in the United States before the invention by the

applicant for patent or (2) a patent granted on an application for patent by another filed

in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the

effects for purposes of this subsection of an application filed in the United States only if

the international application designated the United States and was published under

Article 21(2) of such treaty in the English language.

2.   Claims **1-3, 7-11, 14-16** and **18-20** are rejected under 35 U.S.C. 102(e) as being

clearly anticipated by Mackin et al., US 6,728,877 (hereinafter **Mackin**).

3. In regard to claim **1**, **Mackin** discloses:

- *"A method of migrating configuration data from a first executable product to a second executable product..."*, (E.g., see Figure 1 & Column 4, lines 14-17).

- *"...instructing, from an external agent the first executable product to provide a file containing selected configuration data..."*, (E.g., see Figure 3 & Column 7, lines 20-22), wherein the first executable product is the combination of the extraction application and the application on the source computer, wherein the process is inherently invoked or started by an instruction form an external agent

- *"...and producing, by the first executable product, the file containing the selected configuration data in a format acceptable to the second executable product."*, (E.g., see Figure 3 & Column 7, lines 22-33).

4. In regard to claim **2**, the rejection of base claim **1** is incorporated. **Mackin** further discloses:

- *"...reading the file by the second executable product; and configuring the second executable product for operation using the selected configuration data contained in the file."*, (E.g., see Figure 6B & Column 14, lines 40-45), wherein it is inherent, that after the configuration settings are infused, the second executable file will utilize and thus read them.

5.   In regard to claims **3**, the rejection of base claim **1** is incorporated. Furthermore

Mackin discloses:

> - "...*modifying the first executable product to respond to a command by*
>
> *an external agent...*", (E.g., see Figure 3 & Column 8, lines 9-12), wherein
>
> the first executable product would be responding to an external event,
>
> such as a key on a keyboard.

6.   In regard to claim **7**, the rejection of base claim **1** is incorporated. **Mackin** further

discloses:

> -   "...*modifying the file produced by the first executable product, wherein*
>
> *additional data is incorporated into the file for purposes of configuring*
>
> *the second executable product.*", (E.g., see Figure 7 & Column 15,
>
> lines 11-26), wherein the configuration settings or configuration file
>
> produced by the first executable product is reformatted to conform with
>
> the target.

7.   In regard to claim **8**, the rejection of base claim **7** is incorporated. **Mackin** further

discloses:

> -   "...*performed by editing the file.*", (E.g., see Figure 4 & Column 9, lines
>
> 49-57), wherein the user edits the file before it is applied to the target
>
> computing system.

8.   In regard to claim **9**, the rejection of base claim **7** is incorporated. **Mackin** further

discloses:

- "...*a third executable product*.", (E.g., see Figure 7 & Column 15, lines 19-26), wherein the preparation application is the third executable product.

9.   In regard to claim **10**, the rejections of claim **1** and **3**, are incorporated. Furthermore, **Mackin** discloses:

- "...a function for... ", (E.g., see Figure 4 & Column 7, lines 54-60), wherein it is inherent that the steps described by **Mackin** are implemented in objects in his object-oriented embodiment, in order to be effective.

- "...<u>computer readable program code configured to obtain, responsive to the received command</u>... ", (E.g., see Figure 4 & Column 7, lines 54-60), wherein it is inherent that a function call is responsive to a received command and is computer readable program code.

- "...<u>computer readable program code configured to arrange</u>...<u>to write</u>... ", (E.g., see Figure 4 & Column 7, lines 20-33), wherein computer readable program code is arranged and transitioned (write) to the new computing system.

10.   In regard to claim **11**, the rejections of claim **3** and base claim **10**, are incorporated.

11.   In regard to claim **14**, the rejection of base claim **10** is incorporated. **Mackin** further discloses:

- "...*the external media are persistent*.", (E.g., see Column 15, line 19).

12.   In regard to claim **15**, the rejection of base claim **10** is incorporated. **Mackin**

further discloses:

- "...*disk files.*", (E.g., see Column 5, line 63 – Column 6, line 1).

13.   In regard to claim **16**, the rejection of base claim **10** is incorporated. **Mackin**

further discloses:

- "...*data is obtained from one or more internal control blocks.*", (E.g.,

    see Column 5, lines 50-67).

14.   In regard to claim **18**, the rejections of claims **3, 10** and **15** are incorporated.

Furthermore, **Mackin** discloses:

- "...*configured to output the file to a selected location...*", (E.g., see

    Figure 7 & Column 6, lines 1-6), wherein, "distributing among multiple

    interconnected processing systems" inherently involves outputting data

    or a file to a different or selected location.

- "...*computer readable program code means configured to read being*

    contained in the second computer process.", (E.g., see Figure 7 &

    Column 6, lines 35-37).

15.   Claim **19** is a system version of the method claim of claim **2**. Thus, the rejections

of claim **2** are respectively incorporated in claim **19**.

16.   Claim **20** is a system version of the method claim of claim **10**. Thus, the

rejections of claim **10** are respectively incorporated in claim **20**.

17.   In regard to claim **25**, the rejections of base claim **19** are incorporated.

Furthermore, **Mackin** discloses:

- "...second computer product is a replacement for the first computer product..." (E.g., see column 1, lines 24-26).

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19.   Claims **12, 13** and **17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mackin** in view of Green et al., US 5,969,704 (hereinafter **Green**).

20.   In regard to claim **12**, the rejection of base claim **10** is incorporated. But **Mackin** does not disclose expressly "...*a batch file.*". However, **Green** discloses:

- "...*a batch file.*" (E.g., see Figure 6 & Column 4, lines 18-19).

Mackin and **Green** are analogous art because they are both concerned with the same field of endeavor, namely executable software on a computer apparatus. Therefore, it would have been obvious to someone of ordinary skill in the art, at the time the invention was made, to implement a batch file to perform **Mackin's** method wherein, the external agent is a scripted command issued through execution of a batch file. The motivation to do so was taught by **Mackin's** disclosure of the transition application programmers interface or (API), (Column 6, lines 38-51). **Mackin** further teaches

scripted files and file system I/O, which also implies batch files (Column 8, lines 9-12).

Thus, it would have been obvious, to a person of ordinary skill in the art, to implement a

scripted command by execution of a batch file.

21.   In regard to claim **13**, the rejection of base claim **10** is incorporated. But **Mackin**

does not disclose expressly "*...a system scheduler that issues the command at a

predetermined time.*". However, **Green** discloses:

-    "*...a system scheduler that issues the command at a predetermined

time.*" (E.g., see Column 4, line 64 – Column 5, line 37).

22.   In regard to claim **17**, the rejection of base claim **16** is incorporated. But **Mackin**

does not disclose expressly "*...constructed by the first executable code using

configuration files and command line parameters*". However, **Green** discloses:

-    "*...constructed by the first executable code using configuration files

and command line parameters.*", (E.g., see Column 5, lines 1-50),

wherein the schedule file is interpreted as a configuration file and the

file is transferred to RAM or internal control block, (Column 6, line 11),

where it is processed.

23.   Claims **4, 6, 21** and **22** are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Mackin** in view of Weschler, Jr., US 6,757,720 B1 (hereinafter

Weschler).

24.   In regard to claim **4**, the rejection of base claim **1** is incorporated. But **Mackin**

does not disclose expressly "...*providing a parameter recognized by the first executable*

product". However, **Weschler** discloses:

-    "...*providing a parameter recognized by the first executable product.*"

       (E.g., see Figure 3 & Column 10, line 66 – Column 11, line 24),

       wherein modules are plugged in by specifying a parameter.

Mackin and **Weschler** are analogous art because they are both concerned with

the same field of endeavor, namely a method to programmatically configure a new

software application. Therefore, at the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to combine plug-in modules with **Mackins**

method of configuring a application. The motivation to do so would have been to

enhance, override or overload basic functionality and behavior of an existing program

implemented as built-in functions (**Weschler**, Column 11, line 20).   Furthermore,

Mackin teaches plug-in modules to increase functionality as well. (Column 6, lines 16-

22).

25.   In regard to claim **6**, the rejection of base claim **4** is incorporated. Furthermore

Weschler discloses:

-    "...*recognized during normal operation of the first executable product.*",

       (E.g., see Figure 3 & Column 11, lines 10-24).

26.   In regard to claim **21**, the rejections of base claim **19** are incorporated.

Furthermore **Weschler** discloses:

-    "...*internal tables.*", (E.g., see Figure 3 & Column 7, lines 48-51).

27.   In regard to claim **22**, the rejections of base claim **19** are incorporated.

Furthermore **Weschler** discloses:

-   "...*file.*", (E.g., see Figure 3 & Column 7, lines 52-55).

28.   Claims **5** and **23** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mackin in view of **Weschler** and further in view of obviousness.

29.   In regard to claim **5**, the rejection of base claim **4** is incorporated. But **Weschler**

does not disclose expressly "...*recognized at initial startup of the first executable*

product." However, it would have been obvious to one of ordinary skill in the art, at the

time the invention was made, through **Weschler's** teaching of initializing the plug-in

modules via a parameter, when the configuration manager object is instantiated (E.g.,

see Column 11, lines 5-8), to implement this method upon start-up. It is common

practice and would have been obvious to one or ordinary skill in the art, at the time the

invention was made to initialize any program upon start-up as this feature has been an

option in most operating systems.   The motivation to do so would have been to extend

the functionality of the method disclosed by **Mackin**, by implementing a common and

well known method of parameter initialization upon start-up.

30.   In regard to claim **23**, the rejections of base claim **19** and claim **5** are

incorporated.

31.   Claims **29, 30** and **31** are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Mackin** in view of Aiken JR., et al., US 6,430,622 B1 (hereinafter **Aiken**).

32. In regard to claim **29**, the rejections of base claim **1** are incorporated. But, **Mackin**

does not expressly disclose "...*the first executable product comprises OROUTED and*

the second executable product comprises OMPROUTE". However, **Aiken** discloses:

- "...*the first executable product comprises OROUTED and the second*

executable product comprises OMPROUTE." (E.g., see Figure 1,

Column 17, lines 24-26), wherein OROUTED and OMPROUTE routing

daemons are disclosed.

Mackin and **Aiken** are analogous art because they are both concerned with the

same field of endeavor, namely migrating data from one computer to another on a

network. Therefore, it would have been obvious to someone of ordinary skill in the art,

at the time the invention was made, to implement a batch file to perform **Aiken's**

method with **Mackins'** method of data migration. The motivation to do so was taught by

Mackin's disclosure of the transition application programmers interface or (API),

(Column 6, lines 38-51). **Aiken** further teaches TCP and setting up a connection

between two endpoints (Column 1, lines 21-23). Thus, it would have been obvious, to a

person of ordinary skill in the art, to implement routing deamons with **Mackins'** method
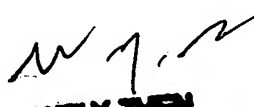
of data migration.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to John J. Romano whose telephone number is (571) 272-

3872. The examiner can normally be reached on 8-5:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

WEI Y. ZHEN
PRIMARY EXAMINER

JJR